

**REMARKS**

By this Amendment, Applicants have amended claim 1. Claims 1-50 remain pending.

In the last Office Action, the Examiner:

- a) rejected claims 27-30, 40, 42, and 45 under 35 U.S.C. § 112, ¶ 2, as indefinite;
- b) rejected claims 1-26 and 32-50 under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- c) rejected claims 25 and 26 under 35 U.S.C. § 102(a) as anticipated by PCT International Publication No. WO 01/18674 ("*Maloney*");
- d) rejected at least claims 1-9, 11-18, 20-24, and 27-47 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of U.S. Patent No. 5,796,932 ("*Fox*");
- e) rejected claim 10 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* and U.S. Patent Application Publication No. 2002/0082869 ("*Anderson*"); and
- f) rejected claim 19 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* and Official Notice.

**REJECTION OF CLAIMS 27-30, 40, 42, AND 45 UNDER 35 U.S.C. § 112, ¶ 2**

Applicants traverse the rejection of claims 1-26 and 32-50 under 35 U.S.C. § 112, ¶ 2 for the following reasons.

The "essential inquiry" pertaining to the requirement for definiteness under § 112 is "whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.02. The M.P.E.P. states:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

Furthermore, the M.P.E.P. makes clear that:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available . . . Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. *Id.*

With regard to claim 27, the Examiner alleged that the recitation of a "*memory for storing a program that accesses local information . . . and generates at least one recommendation . . .*" makes [the] claim confusing, because it is not clear whether the claim [is] directed to a computer-readable medium for storing instructions, or to the system." Office Action ("OA") at page 2 (italics in original).

Claim 27 recites a system, which comprises, *inter alia*, "memory for storing personal information" and "memory for storing a program that accesses local information . . . and generates at least one recommendation." Contrary to the Examiner's allegation, claim 27 is fully compliant with the requirements of 35 U.S.C.

§ 112, ¶ 2. Claim 27 specifically recites that it is directed to a "system," which comprises, *inter alia*, memory for storing personal information and memory for storing a program. Accordingly, claim 27 is not ambiguous as to whether it is directed to a computer-readable medium or to a system, and pursuant to M.P.E.P. § 2173.02, the subject matter defined by claim 27 is set forth with a reasonable degree of clarity and particularity. A skilled artisan would be apprised of the claim's scope from the claim language itself and the supporting disclosure. The language of claim 27 is not "confusing" and, as required by the notice function of § 112, provides "clear warning to others as to what constitutes infringement" of the claimed invention. M.P.E.P. § 2173.02. For at least the reasons noted above, claim 27, and its dependent claims 28 and 29, are fully compliant with 35 U.S.C. § 112, ¶ 2.

With regard to claim 30, the Examiner alleged that the recitation of a "*memory including a program that obtains personal information about a subject*" makes [the] claim confusing, because it is not clear whether the claim [is] directed to a computer-readable medium for storing instructions for performing a method, or to the system." OA at page 2 (italics in original). Contrary to the Examiner's allegation, claim 30 is fully compliant with the requirements of 35 U.S.C. § 112, ¶ 2. Claim 30 specifically recites that it is directed to a "system," which comprises, *inter alia*, memory including a program that obtains personal information about a subject and a processor that runs the program. Accordingly, claim 30 is not ambiguous as to whether it is directed to a computer-readable medium or to a system. The subject matter defined by claim 30 is set forth with a reasonable degree of clarity and particularity and a skilled artisan would be apprised of the claim's scope from the claim language itself and the supporting

disclosure. The language of claim 30 is not "confusing" and provides "clear warning to others as to what constitutes infringement" of the claimed invention. See M.P.E.P.

§ 2173.02. For at least these reasons, claim 30 complies with 35 U.S.C. § 112, ¶ 2.

With regard to claims 40, 42, and 45, they recite, *inter alia*, methods for providing beauty advice "conducted at least in part in a network environment." The Examiner alleged that the term "at least in part" renders these claims indefinite. OA at page 2. According to the Examiner, "[i]t is not clear which part of said method is conducted in a network environment." *Id.* But, contrary to the Examiner's allegations, the subject matter defined by claims 40, 42, and 45 is set forth with a reasonable degree of clarity and particularity. See M.P.E.P. § 2173.02. Further, the M.P.E.P. makes clear that:

Breadth of a claim is not to be equated with indefiniteness. . . .  
If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. (Internal citations omitted). M.P.E.P. § 2173.04

Hence, claims 40, 42, and 45 are not indefinite merely because the breadth of the claims encompasses methods conducted at least in part in a network environment.

Also, the Examiner should note that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." M.P.E.P. § 2173.02. The scope of the subject matter embraced by claims 40, 42, and 45 is clear and Applicants should not be required to further limit the claims merely because the language is not written as the Examiner desires. For at least the above-noted reasons, claims 40, 42, and 45 comply with 35 U.S.C. § 112, ¶ 2.

Accordingly, for at least the above-noted reasons, the § 112, ¶ 2 rejection of claims 27-30, 40, 42, and 45 should be withdrawn.

**REJECTION OF CLAIMS 1-26 AND 32-50 UNDER 35 U.S.C. § 101**

Applicants traverse the rejection of claims 1-26 and 32-50 under 35 U.S.C. § 101 for the following reasons.

The Examiner alleged that the claims are not within the technological arts because they are (1) completely silent with regard to technology, (2) directed to abstract ideas, and (3) not in compliance with M.P.E.P. § 1206 (IV)(B)(2)(b) "Statutory Process Claims." OA at pages 3 and 8.

Regarding the first point, the Examiner alleged that the claims are silent regarding technology because they are completely devoid of any means to carry out a process. OA at page 8. In an attempt to support this, the Examiner cited *In re Musgrave*, 167 U.S.P.Q. 280 (CCPA 1970). OA at page 3. That case, however, states that the presumption that the law "requires all steps of a statutory 'process' to be physical acts applied to physical things" is an "erroneous idea." *In re Musgrave*, 167 U.S.P.Q. at 289. The court noted that "it was a misconstruction to assume that 'all processes, to be patentable, must operate physically upon substances.'" *Id.* at 289. Additionally, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations "reflects a misunderstanding of...[the] case law." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999). Furthermore, in *Ex parte Bowman*, 61 U.S.P.Q.2d 1669 (2001), also cited by the Examiner, the Board's decision to affirm the § 101

rejection was based in part on the fact that neither the claims nor the specification discussed “the use of any technology with respect to the claimed invention.” *Ex parte Bowman*, 61 U.S.P.Q.D.2d at 1671. The Board found that the invention was “not tied to any technological art . . . and [was] not a useful art.” *Id.*

The specification in this application, however, discusses several technological applications related to the claimed invention. Also, claims 12, 17, 26, 40, 42, and 45 specifically recite subject matter related to a network, which clearly involves technology. Further, the Examiner’s allegation that the claims are not within the technological arts because they do not recite means to carry out a process is unsupported. The claims are indeed within the useful or technological arts, regardless of whether they specifically recite means to carry out a process or computer-related limitations. The Examiner provides no authority whatsoever supporting a requirement that a statutory method claim must include limitations reciting means to carry out a process.

Regarding the second point, the Examiner alleged that the claims are directed to abstract ideas because they are no more than a suggested idea of recommending a cosmetic product based on demographic information. OA at page 8. To support this, the Examiner cited *In re Toma*, 197 U.S.P.Q. 852 (CCPA 1978). OA at page 4. That case, however, makes clear that the language in the case law regarding mental steps and technological arts “was not intended to form a basis for a new § 101 rejection” *In re Toma*, 197 U.S.P.Q. at 857. Further, if a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 1375 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed.

Cir. 1999). And, if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101. *See id.*

The Examiner's conclusory statement that the claims are directed to "purely an abstract idea" is unsupported and does not establish that the claims are in fact directed to an abstract idea. OA at page 8. Claims 1-26 and 32-50 do in fact include recitations that produce "concrete, tangible and useful" results and, therefore, accomplish a practical application and are not abstract. *State Street*, 149 F.3d at 1375. For example, generating at least one recommendation for use of at least one cosmetic product based on at least obtained personal information and local information determined based on demographic information, in claim 1, is a useful, non-abstract result that could facilitate, for example, providing beauty advice and improved beauty marketing and sales.

Regarding the third point, the Examiner alleged that the claims do not comply with M.P.E.P. § 1206 (IV)(B)(2)(b) because they "do not include limitations that would suggest a computer is being used" and "there does not appear to be any physical transformation of data." OA at page 8.

M.P.E.P. § 2106(IV)(B)(2)(b) states, however, that a claimed process is statutory if it is "limited to a practical application within the technological arts." Also, M.P.E.P. § 2106(IV)(B)(2)(b)(ii) clearly states that:

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful." (internal citations omitted).

Hence, regardless of whether the claims recite a process that results in a physical transformation outside a computer, the claims are limited to a practical application within the technological arts because the claims produce concrete, tangible and useful results.

Further, the Examiner's allegations are inconsistent. While alleging that the claims "do not include limitations that would suggest a computer is being used," the Examiner also alleged that the claimed "determining" may be "understood as . . . accessing [a] database." OA at page 8. Since accessing a database involves the use of technology, the Examiner's allegation regarding "accessing [a] database" serves only to show that the claims are indeed within the technological arts.

Additionally, M.P.E.P. § 2106(II)(A) states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101 . . . [w]hen such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (internal citations omitted).

In this case, the Examiner failed to establish the *prima facie* showing required by M.P.E.P. § 2106. The Examiner's conclusory statements are unsupported by evidence and do not establish that the claims are in fact "devoid of any limitation to a practical application in the technological arts."

Also, within the context of 35 U.S.C. § 101, the Examiner should consider the accompanying disclosure when construing a claim's practical application. See M.P.E.P. §§ 2106(II)(A). Applicants are entitled to point out portions of the specification to show



that practical application of claims and the Examiner should consider such portions of the specification. In this case, the specification discusses several technological applications related to the invention defined in claims 1-26 and 32-50, thereby showing "a practical application in the technological arts" with respect to those claims.

Therefore, for at least the above-noted reasons, the rejection of claims 1-26 and 32-50 under 35 U.S.C. § 101 should be withdrawn.

**REJECTION OF CLAIMS 25 AND 26 UNDER 35 U.S.C. § 102(a)**

Applicants traverse the rejection of claims 25 and 26 under 35 U.S.C. § 102(a) as anticipated by *Maloney* for the following reasons.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s]." See M.P.E.P. § 2131. Finally, "[t]he elements must be arranged as required by the claim." *Id.*

With regard to claim 25 and its dependent claim 26, *Maloney* fails to teach at least "accessing local information for the geographic area," as recited in claim 25 and required by claim 26. The Examiner alleged (OA at page 9) that *Maloney* teaches the claimed "accessing" because it mentions delivering a test kit including environmental tests (*Maloney*, pg. 11, lines 11-12) and also identifying external conditions, such as water hardness (*Maloney*, pg. 10, lines 7-8). Testing for environmental information, as disclosed by *Maloney*, is not consistent with accessing local information, as claimed.

Furthermore, *Maloney* also fails to teach “generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information of the subject and the local information,” as recited in claim 25 and required by dependent claim 26. In *Maloney*’s system, a consumer “is provided a list of one or more products . . . that correspond to the consumer profiling category” (page 7, lines 13-14). *Maloney* mentions that profiling data can include information obtained from environmental tests (page 11, lines 6-23). *Maloney* also describes identifying, from the consumer, additional profiling data “to customize a product selected from the list to meet the consumer’s physiological conditions and external conditions (such as water hardness, etc.)” (page 10, lines 6-8).

Even if *Maloney*’s “environmental” information were consistent with the claimed “local information,” providing a list of products based on such information does not constitute generating a list of products and then generating a recommendation for a product on that list, such that the recommendation is a function of the personal information of the subject and the local information. The mere act of providing a list of products does not constitute generating a recommendation for use of product on a list of products.

Also, even if *Maloney*’s additional profiling data related to “external conditions” were consistent with the claimed “local information,” customizing a product selected from a list to meet external conditions does not constitute generating a list of products and then generating a recommendation for a product on that list, such that the recommendation is a function of the personal information of the subject and the local

information. Simply customizing a product is not consistent with generating a recommendation.

Accordingly, for at least the above-noted reasons, the rejection of claims 25 and 26 under 35 U.S.C. § 102(a) as anticipated by *Maloney* should be withdrawn.

**REJECTION OF CLAIMS 1-9, 11-18, 20-24, AND 27-47 UNDER 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 1-9, 11-18, 20-24, and 27-47 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* because *prima facie* obviousness has not been established with respect to these claims.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

With regard to independent claim 1, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, at least generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in the amended claim.

In contrast, *Maloney* merely discloses identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions (page 10, lines 6-8). *Fox* merely discloses depicting the effect of weather variables on sales for a given product at a particular location for a particular time period (col. 16, lines 36-39). This may involve collecting data impacted by weather, such as demographical data (col. 9, lines 20-24).

However, neither *Maloney* nor *Fox* teaches or suggests, separately or in combination, generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in claim 1.

Further, there is no motivation to combine *Maloney* and *Fox* to yield the claimed invention. The Examiner alleges that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow to utilize local actual and forecasted weather conditions in planning of sales and advertising of personal care, thereby maximizing profits." OA at page 11. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. This is not the same as generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in claim 1.

With regard to independent claim 27, the Examiner stated that *Maloney* fails to “teach that said local information is determined *based on* said demographic information” and alleged that *Fox* cures these deficiencies. OA at page 10. Claim 27, however, does not recite that local information is determined based on demographic information. Instead, claim 27 recites, *inter alia*, memory for storing a program that accesses local information for the geographic area. Although the Examiner alleged that *Maloney* teaches “determining local information . . . corresponding to . . . demographic information” and that *Fox* discloses “determining local weather information based on . . . demographic information,” the Examiner does not specifically address the accessing local information subject matter recited in claim 27. OA at page 11.

Accordingly, the rejection of claim 27 is ambiguous and improper because the Examiner’s application of *Maloney* and *Fox* to the claim is unclear. For example, it is unclear how the Examiner is applying the references to the accessing local information subject matter of claim 27. Hence, the Examiner’s rejection does not comply with 37 C.F.R. § 1.104(c), which requires the Examiner to explain the pertinence of each reference relied upon. Also, M.P.E.P. § 706 states that “[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.” M.P.E.P. § 706.02(j) further states: “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.” For at least these reasons, the Examiner should provide a new non-final Office Action identifying

how *Maloney* and *Fox* apply to claim 27, if the Examiner continues to dispute the patentability of the claims.

The impropriety of the rejection notwithstanding, neither *Maloney* nor *Fox*, separately or in combination, teaches or suggests “memory for storing personal information about a subject;” “memory for storing a program that accesses local information . . . and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information;” and “a processor that runs the program,” as recited in claim 27.

With regard to independent claims 30 and 31, there is no motivation to combine *Maloney* and *Fox* to yield the claimed invention. The Examiner alleges that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because “it would advantageously allow to utilize local actual and forecasted weather conditions in planning of sales and advertising of personal care, thereby maximizing profits.” OA at page 13 and 14. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer’s physiological and environmental conditions and depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. This is not the same as generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and local information that is based on demographic information, as recited in claims 30 and 31.

With regard to independent claim 32, as affirmed by the Examiner on page 15 of the Office Action, *Maloney* does not disclose, *inter alia*, obtaining local information including a weather forecast, as claimed. *Maloney* therefore does not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes a weather forecast, as claimed. Furthermore, *Fox* does not appear to teach or suggest the claimed “generating.” Even if *Fox* were to disclose obtaining a weather forecast, *Fox* does not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the weather forecast. Because the applied art does not teach or suggest each and every feature of claim 32, *prima facie* obviousness has not been established with respect to that claim

With regard to claim 41, neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests “generating at least one recommendation for use of at least one cosmetic product based on the information,” as recited in the claim. Contrary to the Examiner’s allegations on pages 16 and 17 of the Office Action, *Maloney* does not teach or suggest the claimed “generating.” *Maloney* describes providing a list of products corresponding to a consumer profiling category, and it mentions that profiling data can include information obtained from environmental tests (pages 7, 9, 11). Even if *Maloney*’s environment test data were consistent with “local information” and *Maloney*’s list of products were consistent with “at least one recommendation,” *Maloney*’s disclosure regarding providing a list of products does not teach or suggest the claimed “generating.” That is, providing a list of products based on data received from environmental tests provided to a consumer does not constitute generating at least

one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data, as recited in claim 41.

*Maloney* also describes identifying, from the consumer, additional profiling data “to customize a product selected from the list to meet the consumer’s physiological conditions and external conditions (such as water hardness, etc.)” (page 10, lines 6-8). This functionality does not teach or suggest the claimed “generating.” Customizing a selected product to meet external conditions does not constitute generating at least one recommendation for use of at least one cosmetic product, let alone generating a recommendation based on local information obtained by manipulating received demographic data, as claimed.

*Fox* does not appear to teach or suggest the claimed “generating” and thus fails to cure *Maloney*’s deficiencies. Accordingly, the applied references, taken alone or in combination, fail to teach or suggest each and every feature of claim 41. Hence, for at least these reasons, a case for *prima facie* obviousness has not been established with respect to claim 41.

With regard to claim 43, neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests, *inter alia*, generating at least one cosmetic analysis based on at least one of the personal information and the local information, as recited in the claim. *Maloney*’s list of products could include “consumer services (such as film development)” or “consumer goods (such as beauty care products, clothing, electronics, etc.)” (page 7, lines 14-17). Providing a list of consumer services or goods, however, does not constitute generating at least one cosmetic analysis, as claimed. Further, *Fox* does not appear to teach or suggest “generating at least one cosmetic analysis,” as claimed, and



thus fails to cure *Maloney*'s deficiencies. For at least the reasons advanced above, a case for *prima facie* obviousness has not been established with respect to claim 43.

Accordingly, for at least the above-noted reasons, the rejection of independent claims 1, 27, 32, 41, and 43 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* should be withdrawn.

Further, claims 2-9, 11-18, 20-24 and 48 depend upon claim 1; claims 28 and 29 depend upon claim 27; claims 33-40 depend upon claim 32; claim 42 depends upon claim 41; and claims 44-47 depend upon claim 43. Accordingly, dependent claims 2-9, 11-18, 20-24, 28, 29, 33-40, 42, and 44-48 are allowable at least by virtue of their respective dependence upon allowable base claims 1, 27, 32, 41, and 43, in addition to the patentable subject matter respectively recited therein.

#### **CLAIMS 48-50**

The Examiner did not list claims 48-50 in the rejection statement appearing at page 10 of the Office Action, but addressed them in his explanation of the § 103 rejection based on *Maloney* and *Fox*. Applicants request that the Examiner clarify whether claims 48-50 have in fact been rejected on those grounds.

With regard to claim 48, notwithstanding whether the Examiner has actually rejected that claim under § 103, claim 48 is allowable, as previously noted, at least by virtue of its dependence upon allowable claim 1, in addition to the patentable subject matter recited therein.

With regard to claim 49, notwithstanding whether the Examiner has actually rejected that claim under § 103, the Examiner conceded that *Maloney* fails to disclose

“determining local information based on the demographic information and historical information associated with the geographic area” (see OA at 19) and relied upon *Fox* in attempt to show *prima facie* obviousness. According to the Examiner, a skilled artisan would have modified *Maloney*’s system in view of *Fox* “because it would advantageously . . . utilize local actual and historical weather conditions . . . in planning of sales and advertising of personal care products, thereby maximize profits” (OA at 19).

Even if, as the Examiner alleged, *Fox* were to disclose “determining local weather information based on said demographic . . . information and historical weather information” (OA at 19), *prima facie* obviousness has not been established because the requisite motivation to modify *Maloney* in view of *Fox* is lacking. The Examiner has not shown, by evidence, that a skilled artisan considering *Maloney* and *Fox*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine or modify the references in a manner resulting in Applicants’ claimed combination. The Examiner’s allegations regarding motivation are unsupported by evidence and do not establish that it would have been obvious to modify *Maloney* to perform the “determining” feature recited in claim 49. The Examiner again appears to be improperly using Applicants’ claims in a hindsight manner to reconstruct the prior art.

Accordingly, independent claim 49 is allowable over *Maloney* and *Fox*, and claim 50 is also allowable at least by virtue of its dependence upon allowable claim 49, in addition to the patentable subject matter recited therein.

**REJECTION OF CLAIM 10 UNDER 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claim 10 as unpatentable over *Maloney* in view of *Fox* and *Anderson*.

Claim 10 depends upon claim 1 and includes all limitations recited in claim 1. As discussed above for claim 1, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, at least generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in the claim. *Anderson* fails to cure the deficiencies of *Maloney* and *Fox*. *Anderson* merely discloses a method for providing and updating customized health care information based on an individual's genome (Abstract). The method might include obtaining the personal data of the individual (page 2, ¶ [0016]). This does teach or suggest, separately or in combination with *Maloney* and *Fox*, generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information.

Further, the Examiner alleged that a skilled artisan would have modified *Maloney* and *Fox* with the disclosure of *Anderson* "because it would advantageously allow [a determination and exclusion of] certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition" (OA at 20). In response, Applicants first note that the requisite motivation for combining *Maloney* and *Fox* is lacking for at least the reasons presented above in connection with claim 1. Secondly, the Examiner's allegation that the alleged modification "would advantageously allow [a determination and exclusion of] certain

beauty product ingredients . . .” is not properly supported and does not establish that it would have been obvious to modify *Maloney* in a manner resulting in Applicants’ claimed combination. For example, the Examiner pointed to no mention in *Maloney*, *Fox*, or *Anderson* regarding excluding beauty product ingredients based on negative health conditions or predispositions. The Examiner also failed to show that the alleged motivation would have been in the knowledge generally available to one skilled in the art. Hence, the Examiner is improperly using Applicants’ claims in hindsight to reconstruct the prior art.

Accordingly, for at least the above reasons the rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* and *Anderson* should be withdrawn.

**REJECTION OF CLAIM 19 UNDER 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claim 19 under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of *Fox* and Official Notice.

An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. The features recited in claim 19 were not unquestionably well-known and the Office Action has failed to demonstrate the contrary. Stating that “it is well known that . . . a lot of consumers have a habit to use cosmetic product[s] every day” does not, in and of itself, establish that such subject matter was in fact well known. OA at page 20. Moreover, the Examiner’s allegation that “it is well known that . . . a lot of consumers have a habit to use cosmetic product[s] every day”

does not establish that the “suggesting” feature of claim 19 was unquestionably well-known. That consumers might use cosmetic products daily does not support the assertion that it was well known to suggest “that the subject maintain a stock of the plurality of cosmetic products,” as claimed. Even if it were well known that “a lot of consumers have a habit to use cosmetic product[s] every day,” this subject matter does not constitute “suggesting that the subject maintain a stock of the plurality of cosmetic products.”

M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, that “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted).

Further, M.P.E.P. § 2144.03(B) states that “if Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” Specifically, M.P.E.P. § 2144.03(B) makes clear that:

[If] . . . official notice has been taken of a fact that is asserted to be “common knowledge” without specific reliance on documentary evidence . . . , the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office

action in which the common knowledge statement was made. (internal citations omitted).

The Office Action failed to provide substantial evidence on the record to support the taking of Official Notice. The Examiner merely makes a conclusory statement that certain subject matter was well-known, without supporting documentary evidence and without a clear and unmistakable technical line of reasoning supporting a decision to take the Official Notice.

Applicants traverse the Official Notice and request that the Examiner either cite a competent prior art reference to substantiate the conclusions in the Office Action, or else withdraw the rejection. Applicants also request that, to the extent the Examiner is relying on personal knowledge in alleging that certain features were well-known, the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner's conclusions. *See* M.P.E.P. § 2144.03.

Additionally, *prima facie* obviousness has not been established with respect to claim 19 at least because the requisite motivation to modify *Maloney* in view of *Fox* and Official Notice is lacking. The requisite motivation to modify *Maloney* in a manner resulting in the invention defined by claim 19 is lacking for at least the reasons presented above in connection with claim 1, upon which claim 19 depends. The Examiner's allegation that a skilled artisan would have modified *Maloney* "because without maintaining said stock the consumer may run out of cosmetic product . . . " is not properly supported and does not establish that it would have been obvious to modify *Maloney* in a manner resulting in Applicants' claimed combination.

Finally, as noted above, M.P.E.P. § 2141.02 makes clear that “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). Even if it were obvious or well known that “a lot of consumers have a habit to use cosmetic product[s] every day,” the Examiner failed to establish that claim 19 as a whole, including the “suggesting” feature would have been obvious. For at least the foregoing reasons, the Examiner failed to meet the burden of supporting a *prima facie* conclusion of obviousness.

### **CONCLUSION**

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

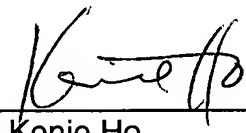
Applicants note that the Office Action contains numerous statements reflecting apparent assertions concerning the related art and claims. Regardless of whether any such statement is addressed specifically herein, Applicants decline to automatically subscribe to any assertion and/or characterization set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 8, 2005

By:   
Kenie Ho  
Reg. No. 51,808